

## **REMARKS**

**[0002]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-3, 5, 8-13, 15, 18, 19, 25-37, and 39-43 are presently pending. Claims amended herein are 1, 8, 11, 18, 25-31, 33, 41 and 43. No claims have been canceled or withdrawn, nor have any new claims been added herein.

### **Statement of Substance of Interview**

**[0003]** The Examiner graciously talked with me—the undersigned representative for the Applicant—on February 4, 2009. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0004]** The Examiner was receptive to the proposals, and I understood the Examiner to indicate that the proposed clarifying claim amendments appeared to distinguish over the cited art of record. However, the Examiner indicated that he would need to review the cited art more carefully and/or do another search, and requested that the proposed amendments be presented in writing.

**[0005]** Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited references of record for at least the reasons discussed during the interview.

**Formal Request for an Interview**

**[0006]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can discuss this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0007]** Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

**Claim Amendments**

**[0008]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 8, 11, 18, 25-31, 33, 41 and 43 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

**[0009]** Claims 1, 11, 25, 33, and 41 are amended to clarify "the viewer-defined preference is a specified value assigned to the viewer-defined events that occur within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer, wherein the specified value is

utilized to rank multiple viewer-defined preferences.” Support for the amendments to claims 1, 11, 25, 33, and 41 are found in the specification at least at page 18.

## **Formal Matters**

### **Non-Statutory Double-Patenting Rejection**

**[0010]** Based upon co-pending application no. 10/969,306, the Examiner rejects claims 1-3, 5, 8-13, 15, 18-19, 25-37 and 39-43 on the grounds of non-statutory obviousness-type double-patenting. Accordingly, Applicant submits herewith a terminal disclaimer to overcome the provisional double-patenting rejection.

**[0011]** Based upon co-pending application no. 10/969,302, the Examiner rejects claims 1-3, 5, 8-13, 15, 18-19, 25-37 and 39-43 on the grounds of non-statutory obviousness-type double-patenting. Accordingly, Applicant submits herewith a terminal disclaimer to overcome the provisional double-patenting rejection.

## **Substantive Matters**

### **Claim Rejections under §102 and §103**

**[0012]** Claims 1-3, 5, 9-13, 15, 18-19, 25-27, 29-37 and 39-41 stand rejected under 35 U.S.C. §102(e) as being anticipated by Menard et al. (U.S. Patent No. 6,810,526).

**[0013]** Claims 8, 18, 28 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Menard in view of Alexander et al. (U.S. Patent No. 6,177,931)

**[0014]** In light of the amendments presented herein and the decisions/agreements reached during the above-discussed Examiner interview, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

### **Anticipation Rejections**

**[0015]** Applicant respectfully submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim as presently amended.<sup>1</sup> Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.<sup>2</sup>

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<sup>1</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

<sup>2</sup> See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

### **Independent Claim 1**

**[0016]** Applicant submits that Menard does not anticipate this claim because it does not disclose at least the following features as recited in this claim (with emphasis added):

- "a viewer-defined preference, wherein **the viewer-defined preference** is a specified value assigned to the viewer-defined events that occur within the two or more electronic presentations that **indicates a priority of the viewer-defined event to the viewer**, wherein the **specified value is utilized to rank multiple viewer-defined preferences**"

**[0017]** The Examiner indicates (Action, p. 6) the following with regard to this claim element:

a viewer defined preference, wherein the viewer defined preference is a specified value assigned to the viewer defined event that occurs within the specified electronic presentation, the specified value assigned to the viewer defined event being assigned a value by the viewer (see Column 3, Lines 28-32 for the viewer further assigning a value to the search that specifies which channels should be included in the search, for example only search news channels (wherein the terms "news" is the value)).

**[0018]** Column 3, lines 28-32 of Menard states:

The central search server 4 is connected via the Internet 6 to a plurality of user terminals 7, normally in the form of personal computers (PCs). The users act as clients to the search server 4. Each user can, at any time, establish a virtual connection over the Internet to the search server 4 and input a particular search profile. For example, this might be a request to search all available channels for a particular sequence of keywords. By way of example, a typical request might be to look for occurrence of the words "Clinton" and "Middle East" in a sequence of say twenty words in order to locate a clip of Bill Clinton talking about the Middle East. When a match is found, the search server 4 sends an alert signal back over the Internet to the address of the requesting PC. The user can specify that the search server is to search through all available channels or only a limited number, for example, news channels or stock market channels and the like. Such requests are stored in the user profile memory to be described below.

**[0019]** Menard is completely silent as to a viewer-defined preference that "a specified value assigned to the viewer-defined events that occur within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer, wherein the specified value is utilized to rank multiple viewer-defined preferences" as presently claimed by independent claim 1. Menard is silent as to a value that indicates the priority of the viewer defined

event. Instead, Menard discloses that certain named channels to be searched can be specified, such as a news channel. The specified search value assigned by the viewer is not in reference to a specific viewer-defined event, but instead a value assigned to the media in which the viewer wants to search.

**[0020]** Further, Menard does not disclose that "the specified value is utilized to rank multiple viewer-defined preferences" as presently claimed by independent claim 1. Instead, Menard simply teaches that the viewer can assign a value to the search. There is no teaching or even suggestion within Menard that the system can utilize the assigned values to rank multiple preferences.

**[0021]** Consequently, Menard does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

### **Dependent Claims 2-3, 5, and 8-10**

**[0022]** These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

### **Independent Claim 11**

**[0023]** Applicant submits that Menard does not anticipate this claim because it does not disclose at least the following features as recited in this claim (with emphasis added):

- “a viewer-defined preference, wherein the viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer, wherein the specified value is utilized to rank multiple viewer-defined preferences”

**[0024]** Menard does not disclose a “viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer” nor that “the specified value is utilized to rank multiple viewer-defined preferences” as presently claimed by claim 11. Similar elements were discussed previously with regard to independent claim 1. As such, claim 11 is allowable for at least the reasoning previously discussed.

**[0025]** Consequently, Menard does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

### **Dependent Claims 12-13, 15 and 18-19**

**[0026]** These claims ultimately depend upon independent claim 11. As discussed above, claim 11 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

### **Independent Claim 25**

**[0027]** Applicant submits that Menard does not anticipate this claim because it does not disclose at least the following features as recited in this claim (with emphasis added):

- “a viewer-defined preference, wherein the viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the specified electronic presentation that indicates a priority of the viewer-defined event to the viewer, wherein the specified value is utilized to rank multiple viewer-defined preferences”

**[0028]** Menard does not disclose a “viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer” nor that “the specified value is utilized to rank multiple viewer-defined preferences” as presently claimed by claim 25. Similar elements were discussed previously with regard to independent claim 1. As such, claim 25 is allowable for at least the reasoning previously discussed.

**[0029]** Consequently, Menard does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

### **Dependent Claims 26-32**

**[0030]** These claims ultimately depend upon independent claim 25. As discussed above, claim 25 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally,

some or all of these claims may also be allowable for additional independent reasons.

**Independent Claim 33**

**[0031]** Applicant submits that Menard does not anticipate this claim because it does not disclose at least the following features as recited in this claim (with emphasis added):

- “a viewer-defined preference, wherein the viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the specified electronic presentations that indicates a priority of the viewer-defined event to the viewer, wherein the specified value is utilized to rank multiple viewer-defined preferences”

**[0032]** Menard does not disclose a “viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer” nor that “the specified value is utilized to rank multiple viewer-defined preferences” as presently claimed by claim 33. Similar elements were discussed previously with regard to independent claim 1. As such, claim 33 is allowable for at least the reasoning previously discussed.

**[0033]** Consequently, Menard does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

## **Dependent Claims 34-37 and 39-40**

**[0034]** These claims ultimately depend upon independent claim 33. As discussed above, claim 33 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

## **Independent Claim 41**

**[0035]** Applicant submits that Menard does not anticipate this claim because it does not disclose at least the following features as recited in this claim (with emphasis added):

- “a viewer defined preference, wherein the viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer, wherein the specified value is utilized to rank multiple viewer-defined preferences”

**[0036]** Menard does not disclose a “viewer-defined preference is a specified value assigned to the viewer-defined event that occurs within the two or more electronic presentations that indicates a priority of the viewer-defined event to the viewer” nor that “the specified value is utilized to rank multiple viewer-defined preferences” as presently claimed by claim 41. Similar elements were discussed previously with regard to independent claim 1. As such, claim 41 is allowable for at least the reasoning previously discussed.

**[0037]** Consequently, Menard does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

### **Dependent Claims 42 and 43**

**[0038]** These claims ultimately depend upon independent claim 41. As discussed above, claim 41 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

## **Obviousness Rejections**

### **Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)**

Applicant disagrees with the Examiner's obviousness rejections. These claims ultimately depend upon independent claims discussed above. As discussed above, claims are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

## **Conclusion**

**[0039]** All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action**. Please call or email me at your convenience.

Respectfully Submitted,

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Representatives for Applicant

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